

CUSTOMER
NUMBER 22852

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PATENT
Attorney Docket No. 2356.0014-09
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08/04/00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

Luc MONTAGNIER et al.

Serial No. 08/470,489

Filed: June 6, 1995

For: RETROVIRUS CAPABLE OF
CAUSING AIDS, MEANS AND
METHOD FOR DETECTING IT
IN VITRO

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:



Group Art Unit: 1648

Examiner: Jeffrey S. Parkin, Ph.D.

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TECH CENTER 1600/2900

REQUEST FOR ORAL HEARING

Under the provisions of 37 C.F.R. § 1.194(b), Appellant requests an oral hearing. This request is timely since it is made within two-months after the date June 19, 2000, of the Examiner's Answer.

A check in the amount of \$260.00, for the required fee under 37 C.F.R. § 1.17(d), is enclosed.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By: Rebecca M. McNeill
Rebecca McNeill
Reg. No. 43,793

Date: July 27, 2000

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REPLY BRIEF

Attorney Docket No. 2356.0014-09

APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

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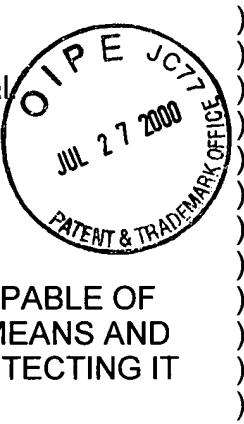
For: RETROVIRUS CAPABLE OF
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Assistant Commissioner for Patents
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Sir:

REPLY BRIEF ON APPEAL UNDER 37 C.F.R. § 1.193(b)(1)

In response to the Examiner's Answer dated June 19, 2000, Appellants submit the following remarks.



Group Art Unit: 1648

Examiner: Jeffrey S. Parkin, Ph.D.

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REMARKS

I. Issues Resolved by Examiner's Answer

In the Examiner's Answer dated June 19, 2000, the Examiner stated: "[t]he statement of the status of the claims contained in the brief is correct"; "[t]he appellant's statement of the status of amendments after final rejection contained in the brief is correct"; "[t]he summary of invention contained in the brief is correct"; and "[t]he copy of the appealed claims contained in the Appendix to the brief is correct." (Examiner's Answer, at 2-3.) Accordingly, the Examiner does not dispute the accuracy of these sections of the brief, or the statements

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contained therein. Thus, Appellants request that the Board adopt the statements in each of these sections.

II. Lack of Specific Response to Appellants' Arguments

The Examiner did not specifically respond to Appellants' arguments in the Examiner's Answer, stating only that:

The following ground of rejection is applicable to the appealed claims: claims 90-109 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection is set forth in prior Office action, Paper No. 27.

(Examiner's Answer, at 3.)

In response to the Office Action of June 7, 1999, Appellants presented several statements of fact and arguments based on those facts. The Examiner has not specifically addressed or challenged any of these points in the Examiner's Answer. Additionally, despite the Examiner's citation to the Office Action of June 7, 1999, that paper does not address or challenge all of these points either.

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First, the Examiner has not addressed Appellants' main argument that the rejected claims are method claims, not composition claims. The cited case law, *Fiers v. Revel*, 984 F.2d 1164, 1171, 25 U.S.P.Q.2d 1601, 1606 (Fed. Cir. 1993) and *Regents of Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1568, 43 U.S.P.Q.2d 1398, 1406 (Fed. Cir. 1997), explores the application of the written description requirement to compositions, not methods. The Examiner has not cited to any decision to show that these cases have been expanded to govern method claims as well, nor has the Examiner indicated that he advocates a change in the law. Additionally, the Examiner does not contest Appellants' statements in the Summary of the Invention section of the Appeal Brief demonstrating that the claimed invention is, in fact, directed to a method. Therefore, Appellants can only assume that the Examiner has no reply to the remarks regarding the inapplicability of the rejection to the present method claims.

Second, the Examiner does not address Appellants' arguments that the specification provides sufficient information on the probes for use in the invention. The Examiner, further, does not address Appellants' argument that the method only requires a precise description of some of the probes that would function in the invention, not all of the probes that could be used in the method.

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The Examiner has not provided reasons for doubting this disclosure. Nor has he addressed the fact that the present invention is directed to methods for detecting nucleic acid, not compositions.

In both of these instances, merely citing back to the prior Office Action does not further prosecution or better clarify the case for appeal. Appellants have presented detailed arguments that the claimed invention was fully described in the specification despite the contentions of the Examiner. Appellants' arguments addressed all of the Examiner's grounds for rejection in great detail. The Examiner has not specifically responded to these arguments, but instead has simply referred to previous general allegations. Appellants submit that the Examiner's lack of specific response to their arguments evidences the incontrovertibility of these arguments.

CONCLUSION

In view of the foregoing remarks, Appellants respectfully submit that the rejection of claims 90-109 under 35 U.S.C. § 112, first paragraph, is in error and should be reversed.

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Respectfully submitted,

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Dated: July 27, 2000